

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Alex M. GREENBERG et al.

Serial No.: 10/684,882

Filed: October 14, 2003

For: Drinking Straw Holder For A Bottle

Examiner: HYLTON, Robin Annette
Group Art: 3781

Mail Stop **Appeal Brief - Patents**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Pre-Appeal Brief Request for Review

SIR:

This is a Request for a Panel Review of Issues on Appeal in accordance with the Office Gazette Notice dated July 12, 2005. The present request is filed concurrently with a Notice of Appeal and is filed before an Appeal Brief. No amendments are being filed with this request.

Arguments supporting the Request for Review begin on page 2 of the present communication.

ARGUMENTS

This Notice of Appeal and Request is filed in response to the final Office Action dated October 29, 2008.

The matters to be review are (1) whether claims 1, 2, 4-9, 11-15, and 17-22 stand rejected under 35 U.S.C. §103 as unpatentable over U.S. Patent No. 5,992,658 (Berger) in view of U.S. Patent No. 6,763,681 (Klundt); and (2) whether claims 1, 2, 4-9, 11-15, and 17-22 stand rejected under 35 U.S.C. §103 as unpatentable over Berger in view of U.S. Published Patent Application No. 2005/0029270 (Marshall).

Rejection over Berger and Klundt

The rejection of claims over Berger and Klundt fails to provide “a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely performs the same function as it does separately”, because the spring of Klundt does not perform the same function as the claimed bottle retaining portion.

Independent claim 1 recites “a bottle retaining portion comprising at least one turn extending around said retaining portion, said at least one turn comprising a first turn having an end attached to said straw support portion, and dimensioned to extend around an outer surface of the bottle, wherein said at least one turn extends spirally around said straw support portion, said at least one turn having an inner edge with an inner radius and an outer edge with an outer radius wherein said inner and outer radii increase substantially continuously around said at least one turn.”

MPEP 2143, citing *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1395-97 (2007), instructs that to support such a rationale, certain points must be

articulated, one of which is “(2) a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely performs the same function as it does separately.”

The Examiner acknowledges that Berger fails to teach or suggest a spirally extending bottle retaining portion. Klundt fails to teach or suggest that which Berger lacks. The apparatus disclosed by Klundt includes three pieces: a ring 12, a spring 16, and a coupling member 18. The ring 12 and coupling member 18 are secured to opposite ends of the spring 16 (see col. 1, lines 28-31 of Klundt).

Since the spring in Klundt is always connected between the ring and the coupling member, it is not predictable that the spring could be used to connect the coupling member to a bottle or any other support. Rather, the spring in Klundt is merely used as a novelty item to connect the ring to the connecting member.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless ~~**>~~the results would have been predictable to one of ordinary skill in the art. *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007) (*see* MPEP 2143.01). As stated above, Klundt teaches that the ring is used to mount the overall apparatus of Klundt to an external support (i.e., a user’s finger), and the spring is used as a novelty to connect the support to the ring. Thus, the spring of Klundt fails to teach or suggest the claimed bottle retaining portion.

In addition, the spring of Klundt fails to teach or suggest “wherein said inner and outer radii increase substantially continuously around said at least one turn”, as expressly recited in independent claim 1. In contrast, the spring of Klundt has a constant radius. Accordingly, independent claim 1 is allowable over Berger and Klundt for at least this additional reason.

For all the above reasons, independent claim 1 is allowable over Berger in view of Klundt.

Independent claims 5, 11, and 14 are allowable over Berger and Klundt for the same reasons as is independent claim 1.

Independent claim 5 further recites “a radial connecting portion connected to said inner edge at said first end of said first turn and to a radially outer edge of straw support portion and connecting said first end of said first turn to said straw support portion.” Klundt discloses that the end of the spring is either glued to holder 18 or threaded into an opening (see col. 2, lines 56-62 of Klundt). Thus, Klundt also fails to teach or suggest a radial connecting portion as recited in independent claim 5. Thus, independent claim 5 is allowable over Berger in view of Klundt, for at least these additional reasons.

In addition, independent claim 11 further recites “wherein said straw support portion and said bottle retaining portion are integrally formed of said sheet material.” There is simply no way, that the spring of Klundt can be considered to be formed of a sheet material. Accordingly, independent claim 11 is allowable over Berger in view of Klundt for at least these additional reasons.

Rejection over Berger and Marshall

The rejection of the claims under Berger in view of Marshall fails to provide “a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely performs the same function as it does separately.”

Independent claim 1 recites “a bottle retaining portion comprising at least one turn extending around said retaining portion, said at least one turn comprising a first turn having an end attached to said straw support portion, and dimensioned to extend around an outer surface of the bottle, wherein said at least one turn extends spirally around said straw support portion, said at least one turn having an inner edge with an inner radius and an outer edge with an outer radius wherein said inner and outer radii increase substantially continuously around said at least one turn.”

The Examiner acknowledges that Berger fails to teach or suggest a spirally extending bottle retaining portion.

Marshall fails to teach or suggest what Berger lacks, because the spiral tether disclosed by Marshall connecting the disk-like body 2 to an inside of a cap 1 of the bottle fails to disclose the claimed bottle retaining portion.

As stated above, an obviousness rejection made by combining elements requires a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely performs the same function as it does separately (see MPEP 2143). In Marshall, the spiral extending portion is used as a tether between the disk-like body 2 and the cap 1. Since the spiral extending portion in Marshall is used to connect the disk-like body 2 to the bottle cap 1, one skilled in the art would not consider

the spiral extending portion to be a bottle retainer. Accordingly, the combination alleged by the Examiner would not yield predictable results to those of ordinary skill in the art.

Moreover, the mere fact that references can be combined or modified does not render the resultant combination obvious unless **>the results would have been predictable to one of ordinary skill in the art. *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007) (*see* MPEP 2143.01). The Examiner states that a smaller bottle would fit into the spiral extending portion. However, Marshall discloses only that the spiral portion allows the disk-like body to remain connected to a straw while the cap is placed on the bottle top. Accordingly, there is no teaching or suggestion that the spiral extending portion of Marshall could function as a bottle retaining portion.

For all of the above reasons, independent claim 1 is allowable over Berger in view of Marshall.

Independent claims 5, 11, and 14 are allowable over Berger and Marshall for the same reasons as is independent claim 1.

With respect to claim 14, Marshall fails to disclose, teach or suggest an adhesive as recited in claim 14 because the disk-like body 2 of Marshall is designed to be inside the bottle.

Accordingly, independent claim 14 is allowable over Berger in view of Marshall for at least these additional reasons.

For the foregoing reasons, it is respectfully submitted that appellant's claims are not rendered obvious by and are, therefore, patentable over the art of record, and the Examiner's rejections should be reversed.

Respectfully submitted,
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